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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,959	09/03/2004	Alexander Shipp	117-513	1444

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901 NORTH GLEBE ROAD, 11TH FLOOR
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EXAMINER

JUNG, DAVID YIUK

ART UNIT	PAPER NUMBER
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2134

MAIL DATE	DELIVERY MODE
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10/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,959

Applicant(s)

SHIPP, ALEXANDER

Examiner

David Y. Jung

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2007/2004</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

CLAIMS PRESENTED

Claims 1-10 are presented.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Regarding claims 1-10, the claimed invention is directed to non-statutory subject matter. Claims recite only perfunctory recitation of functional material (object, document, links, etc.). Aside from this, the claims recite only nonfunctional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance.

USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384, 217 USPQ at 403; see also Diehr, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

For further guidance on the term "nonfunctional", please see MPEP 2106.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch (WO-0065483-A2).

Regarding claim 1, Hirsch teaches "A content scanning system for electronic documents such as [] comprising:

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a) a link analyser for identifying hyperlinks in document content (section 3, automatic parsing so as to identify such hyperlinks); b) means for causing a content scanner to scan objects referenced by links identified by the link analyser and to determine their acceptability according to predefined rules, the means being operative, when the link is to an object external to the document and is determined by the content analyser to be acceptable, to retrieve the external object and modify the document by b1. embedding in it or attaching to it the retrieved copy of the object (section 3.2 layout parser finds links and retrieves in such fashion); and b2. replacing the link to the external object by one to the copy embedded in, or attached to, the document (section 4, content is classified and copied in such fashion. Because the content itself and not the link is copied, this would amount to replacing the link by a copy of the content of the link).

These passages of Hirsch do not teach "emails" in the sense of the claim.

Nevertheless, it was well known in the art to scan emails for the motivation of finding content. Indeed, scanning of emails was routinely used before scanning of the Internet (because emails are of smaller size than the Internet itself).

Also, the purpose of the claim (security against unwanted links to harmful software, etc.) is not clearly stated in Hirsch. To some degree, the claim's "replacing the link" is directed to that purpose. At section 3.2, Hirsch teaches to identify links to be advertisements, news, etc. Upon identifying a link to have disruptive elements, such links would be filtered out (along with other unwanted elements, such as advertisements). If Hirsch teaches to identify and deal with unwanted elements such as advertisements, one of ordinary skill in the art applying Hirsch would filter out even more

unwanted elements (because harmful software is even more unwanted than advertisements).

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify the teachings of Hirsch for the motivation noted in the previous paragraphs so as to teach the claimed invention.

2.A system according to claim 1 wherein the link analyser a) and means b) are operative to recursively process links identified in such external objects.

Section 5, the third paragraph. Hirsch teaches links to links in such fashion.

3.A system according to claim 2 in which only a maximum depth of recursion is permitted and the document is flagged as unacceptable if that limit is reached.

Section 5, the third paragraph. Hirsch teaches that the maximum depth of links may be set to any number. Also Hirsch provides an alternative in which the links are scored for potential usefulness before going further into the links.

4.(currently amended) A system according to claim 1 wherein acceptable retrieved objects are encoded into MIME format.

MIME format is the usual email format. Thus, this is well known to those of ordinary skill in the art.

5.(currently amended) A system according to claim 1, wherein if any linked-to object is determined by the content scanner to be unacceptable the document is flagged or modified to indicate that fact.

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At section 3.2, Hirsch teaches to classify links and to identify links and to store links in such fashion. For example, Hirsch teaches to identify links to be advertisements, news, etc. Upon identifying a link to have disruptive elements, such links would be filtered out (along with other unwanted elements, such as advertisements

Claims 6-10 are method analogs of claims 1-5. For the reasons noted in the rejections of claims 1-5 are unpatentable.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

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(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Kambiz Zand whose telephone number is (272) 272-3811.

David Jung

Patent Examiner

10/19/07

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke extending to the right.